

APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Edward O. Clapper Examiner: Cam Y. Truong
Serial No.: 10/020,483 Group Art Unit: 2162
Filed: December 12, 2001 Docket: 884.611US1
For: SYLLABIC SEARCH ENGINES AND RELATED METHODS (As Amended)

APPEAL BRIEF UNDER 37 CFR § 41.37

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in response to the Notice of Panel Decision from Pre-Appeal Brief Review mailed on February 2, 2007, and further in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on January 16, 2007, from the Final Rejection of claims 5-30 of the above-identified application, as set forth in the Final Office Action mailed on July 14, 2006.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of \$500.00 which represents the requisite fee set forth in 37 C.F.R. §41.20(b)(2). The Appellants respectfully request consideration and reversal of the Examiner's rejections of pending claims.

1. REAL PARTY IN INTEREST

The real party in interest of the above-captioned patent application is the assignee,
INTEL CORPORATION.

2. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings known to Appellant, Appellant's legal representative, or the Assignee that are related to, will directly affect, be affected by, or have a bearing on the Board's decision in the instant Appeal.

3. STATUS OF THE CLAIMS

The present application was filed on December 12, 2001 with claims 1-30.

A Non-Final Office Action, including Restriction Requirement, was mailed on March 25, 2004. Non-elected claims 1-4 were canceled in the Amendment filed on July 22, 2004 in response to the Non-Final Office Action and Restriction Requirement.

A Final Office Action was mailed on November 30, 2004.

A second Non-Final Office Action and third Non-Final Office Action were mailed on May 23, 2005 and January 12, 2006, respectively.

A second Final Action (hereinafter “the Final Office Action) was mailed on July 14, 2006.

Claims 5-30 stand rejected multiple times, remain pending, and are the subject of the present appeal.

4. STATUS OF AMENDMENTS

No amendments have been made subsequent to the Final Office Action mailed July 14, 2006.

5. SUMMARY OF CLAIMED SUBJECT MATTER

This summary is presented in compliance with the requirements of Title 37 C.F.R. § 41.37(c)(1)(v), mandating a “concise explanation of the subject matter defined in each of the independent claims involved in the appeal . . .”. Nothing contained in this summary is intended to change the specific language of the claims described, nor is the language of this summary to be construed so as to limit the scope of the claims in any way.

In general, before presenting a brief summary of each independent claim, an overview of some embodiments of the invention will first be provided. Some embodiments of the invention are related to a search engine to locate a document (including, but not limited to, a song, poem, speech, book, movie or television episode, or the like), by entering a search string (FIG. 5) comprising an ordered sequence of syllable counts (406, FIG. 5). (Please note that reference numeral 406, and not the lower reference numeral 404, should identify the “EXAMPLE OF SEARCH SEQUENCE” in FIG. 5.) In some embodiments, the search string may include a word in place of the word’s syllable count (e.g. the word “WHAT”, 406, FIG. 5). Using the search string, a computing device (2, 26, and 28, FIG. 1) may search a document database (112, FIG. 2) and display the best matches or “hits” satisfying the search string (306, FIG. 4). In some embodiments, a document uniquely represented by the search string is retrieved.

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal will now be presented.

Some embodiments of the invention are related to a method, to be performed on a computing device (2, 26, and 28, FIG. 1), by receiving a search string (302, FIG. 4) including an ordered sequence of syllable counts (406, FIG. 5), comparing the ordered sequence of syllable counts with the contents of a database of analyzed documents (304, FIG. 4), each document comprising a plurality of words (See Application, page 8, lines 10-11), and retrieving from the database a document uniquely represented by the search string (page 9, lines 10-11).

Some embodiments of the invention are related to a computing device (2, 26, and 28, FIG. 1) including a memory to store a database (20, FIG. 1; 112, FIG. 2), and a user interface (6, 8, FIG. 1; 102, 104, FIG. 2), the computer executing a computer program (20, FIG. 1; 110, FIG.

2) comprising the operations of receiving via the user interface a search string including an ordered sequence of syllable counts (302, FIG. 4), comparing the ordered sequence of syllable counts with the contents of the database (304, FIG. 4), the database comprising a plurality of analyzed documents (page 6, lines 9-14), each document comprising a plurality of words (page 8, lines 10-11), and retrieving from the database a document uniquely represented by the search string (page 9, lines 10-11).

Some embodiments of the invention are related to a computer network (24, FIG. 1) including a computing device (2, FIG. 1) having a user interface (6, 8, FIG. 1), and a remote computing device (26, 28, FIG. 1) having a remote memory to store a database (112, FIG. 2) and a computer program (110, FIG. 2), the computer network executing the computer program and comprising the operations of receiving via the user interface a search string including an ordered sequence of syllable counts (302, FIG. 4), comparing the ordered sequence of syllable counts with the contents of the database (304, FIG. 4), the database comprising a plurality of analyzed documents (page 6, lines 9-14), each document comprising a plurality of words (page 8, lines 10-11), and retrieving from the database a document uniquely represented by the search string (page 9, lines 10-11).

Some embodiments of the invention are related to an article comprising a computer-accessible medium (page 7, line 3; 20, FIG. 1) having associated instructions, wherein the instructions, when accessed, result in a machine performing a method comprising receiving a search string including an ordered sequence of syllable counts (302, FIG. 4), comparing the ordered sequence of syllable counts with the contents of a database of analyzed documents (304, FIG. 4), each document comprising a plurality of words (page 8, lines 10-11), and retrieving from the database a document uniquely represented by the search string (page 9, lines 10-11).

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Appellants refer to the appended claims and their legal equivalents for a complete statement of the inventive subject matter.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 5-8, 10, 11, 13-15, 17, 20-22, 24, and 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki (U.S. 6,689,946) in view of Berke (U.S. 6,629,094).

Claims 9, 16, and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Erickson (U.S. 5,765,152).

Claims 12, 18, 19, 25, 26, and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Wu (U.S. 5,991,756).

7. ARGUMENT

7.1 35 U.S.C. §103 REJECTIONS

7.1.1 The Applicable Law

The Examiner has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d (BNA) 1596, 1598 (Fed. Cir. 1988). The MPEP contains explicit direction to the Examiner that agrees with the *In re Fine* court:

In order for the Examiner to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP §2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d (BNA) 1438 (Fed. Cir. 1991)).

The test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985). References must be considered in their entirety, including parts that teach away from the claims. See MPEP §2141.02.

The Examiner must avoid hindsight. MPEP §2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)). That is, the Examiner cannot use the Appellant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. *In re Gorman*, 933 F.2d 982, 987, 18 USPQ 2d (BNA) 1885, 1888 (Fed. Cir. 1991). If the proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP §2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

7.1.2 The Examiner's Rejection and Appellant's Arguments

Claims 5-8, 10, 11, 13-15, 17, 20-22, 24, and 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki (U.S. 6,689,946) in view of Berke (U.S. 6,629,094).

Claims 9, 16, and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Erickson (U.S. 5,765,152).

Claims 12, 18, 19, 25, 26, and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Wu (U.S. 5,991,756).

7.1.3 Discussion of the Rejection of Claims 5-8, 10, 11, 13-15, 17, 20-22, 24, and 27-29 under 35 U.S.C. §103(a) as being unpatentable over Funaki (U.S. 6,689,946) in view of Berke (U.S. 6,629,094).

Claims 5-8, 10, 11, 13-15, 17, 20-22, 24, and 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki (U.S. 6,689,946) in view of Berke (U.S. 6,629,094).

This rejection is respectfully traversed. Appellant respectfully submits that the Final Office Action has failed to make a proper *prima facie* showing of obviousness, at least because neither Funaki nor Berke disclose “an ordered sequence of syllable counts”, as recited in each of Appellant’s independent claims 5, 13, 20, and 27.

Brief Synopsis of Funaki and Berke

Funaki discloses a computer-based song-writing system for retrieving candidate words to match corresponding music (see col. 12, lines 7-28). The candidate words may be selected in part based upon the number of syllables they contain, and in part based upon the words’ part of speech. It is noted that in Funaki the search engine does not retrieve from the database a unique hit, but rather the search engine may retrieve several candidate words (see col. 8, lines 44-45). Further, it will be noted that in Funaki the search engine retrieves individual words rather than a document.

Berke discloses a search engine that provides a unique hit (e.g., in the form of a web site) for each combination of a trademark and an associated product or service. (See Abstract.) However, Berke does not mention anything about “syllables”.

***Neither Funaki Nor Berke Discloses
An Ordered Sequence of Syllable Counts***

Regarding Appellant’s independent claims 5 and 27, the Final Office Action asserts that Funaki teaches “receiving via the user interface a search string including an ordered sequence of syllable counts”¹ (citing Col. 1, lines 20-22; and Col. 8, lines 5-30). However, Appellants strongly traverse this. The portion of Funaki cited by the Office discusses detecting the number of syllables of a given melody, so that words matching the number of syllables are derived from a “poem piece data bank”. Funaki is only concerned with composing song words to match a melody (Col. 1, lines 43-44).

Thus, an “ordered sequence of syllables counts” is definitely not shown by Funaki. Funaki receives only a number of syllables – not an “ordered sequence of syllable counts”, as recited in each of Appellant’s independent claims 5, 13, 20, and 27.

Appellant’s FIG. 5 depicts an example of a “syllable sequence” 404, such as the syllable sequence 1, 1, 3, 1, 1, 2, 1, 1, 2. In each of Appellant’s independent claims 5, 13, 20, and 27, an “ordered sequence of syllable counts” is compared with the contents of a database of analyzed documents. This is not shown anywhere in Funaki.

The Office, in the “Response to Arguments”, quotes from Funaki (col. 1, lines 20-22). The Office equates Funaki’s “poem piece data bank” with a search string having an ordered sequence of syllable counts². Appellant vigorously disagrees. Col. 1, lines 20-22 of Funaki states:

“The apparatus also detects the number of syllables of a given melody so that words matching the number of syllables are derived from the ‘poem piece data bank.’”

¹ Final Office Action, page 7, lines 1-2.

² *Ibid.*, page 2, lines 5th paragraph.

There is nothing in the quoted language that describes an ordered sequence of syllable counts. It merely discusses detecting the number of syllables (i.e. a total count, not an ordered sequence of counts) of a given melody, and finding words to match that number.

Moreover, the language referred to by the Examiner is not musically accurate. Music *per se* doesn't have syllables. Music is composed of notes of specified time duration and pitch. As best understood, the quoted language appears to refer to counting the distinct pitch changes within a given melodic fragment and then trying to match a word to that fragment.

From a careful reading of Funaki as a whole, it appears to contain no disclosure whatsoever about an "ordered sequence of syllable counts". To the contrary, Funaki describes and employs only "number of syllables" (col. 8, lines 7 and 35); "syllable number count" (col. 8, line 36); "counted number of syllables" (col. 8, lines 37-38); "two-syllable word" (col. 8, line 41); etc.

Funaki only shows a syllable count and a part of speech being compared with words registered in the dictionary J, whereas in Appellant's independent claims 5, 13, 20, and 27 an "ordered sequence of syllable counts" (e.g., 1, 1, 3, 1, 1, 2, 1, 1, 2, as one example, described beginning at page 9, line 30 of Appellant's written description) is compared with the contents of a database of analyzed documents. These are very different operations. Anyone of ordinary skill in this art will appreciate that Appellant's syllable count sequence "1, 1, 3, 1, 1, 2, 1, 1, 2" is very different from Funaki's search condition consisting of a syllable count and a part of speech.

To summarize, neither Funaki nor Berke disclose an "ordered sequence of syllable counts".

*The Examiner's Suggested Combination of
Funaki and Berke Would Defeat
The Purposes of Funaki's System*

The Office asserts that it would have been obvious to a person of ordinary skill in the art to apply Berke's teaching of uniquely identifying a single web site corresponding to search criteria, by examining Funaki's database for a unique combination stored in the database in order

to save time for users reading or searching documents and to eliminate displaying irrelevant documents to a user³.

Appellant respectfully traverses the Office's argument. Motivation is lacking in the Funaki system to retrieve a unique word and display it to the song-writer user. The objective of the Funaki system is not necessarily to improve time efficiency, but rather it is to produce an artistic work having an aesthetic effect. This inherently requires the retrieval and display of candidate words and the song-writer user's careful and artistic evaluation and selection of the optimum word (see col. 2, lines 29-30; col. 12, lines 21-25). In Funaki, the search result list display unit H displays a search result list (col. 9, lines 36-39), and the user selects a word from the search result list (col. 9, lines 53-56). To retrieve just a single word, as the Office suggests, would defeat the ability of the Funaki system to allow the individual user some artistic evaluation and to personally choose a word that he or she likes.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine them to arrive at Appellant's claimed subject matter. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. MPEP §2143.

Thus, Appellant respectfully asserts that a *prima facie* case of obviousness has not been established, because motivation to combine Funaki and Berke is lacking, since such a combination would defeat the purpose of the Funaki system.

***The Rejection of Claims 5-8, 10, 11, 13-15, 17, 20-22, 24, and 27-29
Based Upon a Combination of
Funaki and Berke Should be Withdrawn***

For the above reasons, independent claims 5, 13, 20, and 27 should be found to be allowable over any asserted combination of Funaki and Berke, and Appellant respectfully requests that the rejection of claims 5, 13, 20, and 27 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke should be reversed.

³ *Ibid.*, page 7, last paragraph.

7.1.4 Discussion of the Rejection of Dependent Claims 9, 16, and 23 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Erickson (U.S. 5,765,152)

Claims 9, 16, and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Erickson (U.S. 5,765,152).

Erickson discloses a system to provide access to copyrighted media. However, there is no mention of “syllable” in Erickson. Nor is there any mention of an “ordered sequence of syllable counts”. Thus, the Office’s suggested combination of Erickson with Funaki and Berke still fails to teach or suggest all of the claim limitations present in independent claims 5, 13, 20, and 27, so a *prima facie* case of obviousness has not been established.

Moreover, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *MPEP §2143.03*. Independent claims 5, 13, and 20 are asserted to be patentable over Funaki in view of Berke for the reasons presented by Appellant above. Thus, claims 9, 16 and 23, which indirectly depend from claims 5, 13, and 20, respectively, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above, and Appellant respectfully requests that the rejection of claims 9, 16 and 23 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Erickson should be withdrawn.

7.1.5. Discussion of Dependent Claims 12, 18, 19, 25, 26, and 30 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Wu (U.S. 5,991,756).

Claims 12, 18, 19, 25, 26, and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Wu (U.S. 5,991,756).

Wu discloses a search engine to retrieve documents matching a query term that may comprise a plurality of sub-terms. However, there is no mention of “syllable” in Wu. Wu also fails to disclose any “ordered sequence of syllable counts”. Thus, the Office’s suggested combination of Wu with Funaki and Berke still fails to teach or suggest all of the claim limitations present in independent claims 5, 13, 20, and 27, so a *prima facie* case of obviousness has not been established.

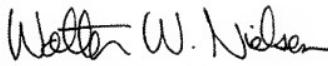
Moreover, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *MPEP §2143.03*. Independent claims 5, 13, 20, and 27 are asserted to be patentable over Funaki in view of Berke for the reasons presented by Appellant above. Thus, claims 12, 18, 19, 25, 26, and 30, which directly or indirectly depend from independent claims 5, 13, 20, and 27, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above, and Appellant respectfully requests that the rejection of claims 12, 18, 19, 25, 26, and 30 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Berke and further in view of Wu should be withdrawn.

8. SUMMARY

For the reasons argued above, claims 5-30 should be patentable over any combination of Funaki, Berke, Erickson and/or Wu.

It is respectfully submitted that the documents cited do not render the claims unpatentable and that the claims are patentable over the cited documents. Reversal of the rejections and allowance of the pending claims are respectfully requested.

Respectfully submitted,
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CLAIMS APPENDIX

5. A method comprising:

 a computing device receiving a search string including an ordered sequence of syllable counts;

 comparing the ordered sequence of syllable counts with the contents of a database of analyzed documents, each document comprising a plurality of words; and

 retrieving from the database a document uniquely represented by the search string.

6. The method recited in claim 5 wherein, in receiving, the search string includes a word in place of the word's syllable count.

7. The method recited in claim 5 wherein, in receiving, the search string includes two words in place of each respective word's syllable count.

8. The method recited in claim 5 wherein, in using, the database comprises a plurality of records, each comprising an ordered listing of words and an ordered syllable count listing.

9. The method recited in claim 8 wherein, in using, each database record comprises a work from the group comprising a literary work, a song lyric, a dramatic work, a motion picture script, and an audiovisual script.

10. The method recited in claim 5 wherein, in using, the input ordered sequence of syllable counts is matched with at least one corresponding ordered sequence of syllable counts within the database.

11. The method recited in claim 5 wherein the computing device comprises a display, and wherein the method further comprises:

displaying the document via the display.

12. The method recited in claim 11 wherein, in using, a plurality of documents are retrieved, and wherein the method further comprises:

displaying the plurality of documents via the display.

13. A computing device including a memory to store a database, and a user interface, the computer executing a computer program comprising the operations of:

receiving via the user interface a search string including an ordered sequence of syllable counts;

comparing the ordered sequence of syllable counts with the contents of the database, the database comprising a plurality of analyzed documents, each document comprising a plurality of words; and

retrieving from the database a document uniquely represented by the search string.

14. The computing device recited in claim 13 wherein, in receiving, the search string includes a word in place of the word's syllable count.

15. The computing device recited in claim 13 wherein, in using, the database comprises a plurality of records, each comprising an ordered listing of words and an ordered syllable count listing.

16. The computing device recited in claim 15 wherein, in using, each database record comprises a work from the group comprising a literary work, a song lyric, a dramatic work, a motion picture script, and an audiovisual script.

17. The computing device recited in claim 13 wherein, in using, the input ordered sequence of syllable counts is matched with at least one corresponding ordered sequence of syllable counts within the database.

18. The computing device recited in claim 13 wherein the computer program further comprises the operation of:

displaying the document via the user interface.

19. The computing device recited in claim 18 wherein, in using, a plurality of documents are retrieved, and wherein the computer program further comprises the operation of:

displaying the plurality of documents via the display.

20. A computer network including a computing device having a user interface, and a remote computing device having a remote memory to store a database and a computer program, the computer network executing the computer program and comprising the operations of:

receiving via the user interface a search string including an ordered sequence of syllable counts;

comparing the ordered sequence of syllable counts with the contents of the database, the database comprising a plurality of analyzed documents, each document comprising a plurality of words; and

retrieving from the database a document uniquely represented by the search string.

21. The computer network recited in claim 20 wherein, in receiving, the search string includes a word in place of the word's syllable count.

22. The computer network recited in claim 20 wherein, in using, the database comprises a plurality of records, each comprising an ordered listing of words and an ordered syllable count listing.

23. The computer network recited in claim 22 wherein, in using, each database record comprises a work from the group comprising a literary work, a song lyric, a dramatic work, a motion picture script, and an audiovisual script.

24. The computer network recited in claim 20 wherein, in using, the input ordered sequence of syllable counts is matched with at least one corresponding ordered sequence of syllable counts within the database.

25. The computer network recited in claim 20 wherein the computer program further comprises the operation of:

displaying the document via the user interface.

26. The computer network recited in claim 25 wherein, in using, a plurality of documents are retrieved, and wherein the computer program further comprises the operation of:

displaying the plurality of documents via the display.

27. An article comprising a machine-accessible medium having associated instructions, wherein the instructions, when accessed, result in a machine performing:

receiving a search string including an ordered sequence of syllable counts;

comparing the ordered sequence of syllable counts with the contents of a database of analyzed documents, each document comprising a plurality of words; and

retrieving from the database a document uniquely represented by the search string.

28. The article of claim 27 wherein, in using, a pattern-matching algorithm matches the input ordered sequence of syllable counts with at least one corresponding ordered sequence of syllable counts within the database.

29. The article of claim 27 wherein the machine comprises a display, and wherein the instructions, when accessed, result in the machine performing:

displaying the document via the display.

30. The article of claim 27 wherein the machine comprises a display;
wherein, in using, a plurality of documents are retrieved; and
wherein the instructions, when accessed, result in the machine performing:
generating a list of best-matched hits; and
displaying the list of best-matched hits via the display.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.